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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,126	01/12/2001	Kazuhiro Tsujita	Q61243	8903
7590	05/19/2006		EXAMINER	
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, N.W., Washington, DC 20037-3202				MANTIS MERCADER, ELENI M
		ART UNIT	PAPER NUMBER	3768

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/758,126	TSUJITA ET AL.	
Examiner	Art Unit		
Eleni Mantis Mercader	3768		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Statys

1)  Responsive to communication(s) filed on 15 March 2006.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-15 and 33-43 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-15 and 33-43 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on 3/15/2006 have been fully considered but they are not persuasive. Applicant should note that the rejection is not under a 102 but rather under a 103. The Examiner explained that while there is no explicit mention of thresholds or values, still the Palcic et al.'190 reference teaches the use of a remittance image to account for non-uniformity due to different changes including illumination intensity (see col. 2, lines 28-31). The prosecution of the case is re-opened in order to address the newly added claims 39-43.

### ***Claim Objections***

2. Claims 39-43 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The claims merely recite the response of the tissue to excitation light, which is a natural process rather than how the invention utilizes that response to provide a useful result. As such these responses do not further limit.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 39-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims recite the natural response of a tissue to excitation light. As such they do not fall under the statutory categories of invention.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-15 and 33-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palcic et al.'190 (US Patent 5,827,190).

Palcic et al.'190 teach normalization of at least one fluorescence image by using a remittance image or as otherwise stated, reflected reference light image, in order to correct for many factors including light intensity allowing for differentiation of normal and diseased tissue (see col. 2, line 20-col. 3, line 37). Palcic et al.'190 teaches the use of a remittance image to account for non-uniformity due to different changes including illumination intensity (see col. 2, lines 28-31).

While Palcic et al.'190 do not specifically address specified values, it would have been obvious to one skilled in the art at the time that the invention was made that the normalization process necessarily incorporates specified values or thresholds in order to differentiate normal from abnormal tissue as this is well within the knowledge of skilled artisans.

With respect to the newly added claims, necessarily the detected values of fluorescence will be above or below the remittance value depending on whether the tissue is normal or abnormal.

7. Any inquiry concerning this communication should be directed to Eleni Mantis Mercader at telephone number (571) 272-4740.



Eleni Mantis Mercader  
SPE  
Art Unit 3768